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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/812,719

03/29/2004

Pavel Berkhin

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3740

29989

7590

09/22/2006

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EXAMINER

VY, HUNG T

ART UNIT

PAPER NUMBER

2163

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/812,719

Applicant(s)

BERKHIN, PAVEL

Examiner

Hung T. Vy

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/27/2004 and 10/12/2005</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION
Acknowledges

1. Receipt is acknowledged of the following items from the Applicant.

Information Disclosure Statement (IDS) filed on 12/27/2004 and 10/12/2005. The references cited on the PTOL 1449 form have been considered.

Specification

2. The specification has been checked to the extent necessary to determine the presence of possible minor errors. However, the applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Drawings

3. The informal drawings are not of sufficient quality to permit examination. Accordingly, replacement drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to this Office action. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

Applicant is given a TWO MONTH time period to submit new drawings in compliance with 37 CFR 1.81. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a). Failure to timely submit replacement drawing sheets will result in ABANDONMENT of the application.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 2163

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1, the phrase "authority weights" renders the claim indefinite because it is not clear the authority weight bases on what item.

With respect to claim 1, line 5, the phrase "initial authority weight" renders the claim indefinite because it is not clear what is the different between the "initial authority weight" and "input authority weight".

Claim 1 provides for the use of resulting authority weight for a page in effecting a search result list, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claims 2-6 depend from rejected claim 1 thereby render these dependent claims indefinite

Claim Rejections - 35 USC, 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 1-6 are rejected under 35 U.S.C. 101 because the claims are directed to a non-statutory subject matter, specifically, the claims are not directed towards the final result that is "useful, tangible and concrete".

(See State Street, 149 F.3d at 1373-74 USPQ2d at 1601-02).

According to the New Guidelines of October 26, 2005, which states that "A claim limited to a machine or manufacture, which has a practical application, is statutory. In most cases a claim to a specific machine or manufacture will have a practical application. See Alappat, 33 F.3d at 1544, 31 USPQ2d at 1557)... a specific machine to produce a useful, concrete, and tangible result and State Street, 149 F.3d at 1373-74 USPQ2d at 1601-02).

(Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility

<http://rs6.net/tn.jsp?t=mdmd7pbab.0.kbg76pbab.p9qiiibab.7440&p=http%3A%2F%2Fwww.uspto.gov%2Fweb%2Foffices%2Fpac%2Fdapp%2Fopla%2Fpreognotice%2Fguidelines101_20051026.pdf>)

Examiner requests Applicant to include in Applicant's claimed limitations (in all the claims) the following:

What is the practical application?

What is the result?

What is final result that is concrete, useful and tangible?

Because the "practical application, result, concrete, useful and tangible"

Art Unit: 2163

limitations are not claimed in Applicant's claims, Examiner believes that the above listed claims are nonstatutory.

Further, in the claim 1, the method for generating search preferences from user input does not produce a useful, concrete and tangible result as set forth in 2106 (IV)(B)(2)(b)(ii), e.g. *using a resulting authority weight for a page in effecting a search result list* is not a tangible result because *a resulting authority weight for a page in effecting a search result list* is not being used in the method *for generating search preferences from user input* as recited in the preamble. The claim invention does not produce a useful because the process does not meet the requirement as recited in the preamble, e.g., *generating search preferences from user input*.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 1 is rejected under 35 U. S. C. § 102 (a) as being anticipated by Page et al. ("The PageRank Citation Ranking: Bringing Order to the Web", internet citation, 29 January 1998, XP00221358).

With respect to claim 1, as best understood, Page et al. discloses a computer-implemented method for generating search preferences from user input, the method comprising: identifying input authority weights for a plurality of pages (the ranks backlinks)(page 3, line 18-19), wherein an input authority weight represents a user's weight of a page in terms of interest (a start vector for PageRank)(see 13, line 19-20, page 7, line 13-14, page 11, line 17-18); distributing a page's initial authority weight over one or more pages that are linked in a graph to the page(page 4 line 1-2) with distribution occurring recursively over links and pages until an end condition is met (page 4, line 4-6); and using a resulting authority weight for a page in effecting a search result list (page 15, line 13-15, page 15 lines 24-25).

8. Claims 1-2 are rejected under 35 U. S. C. § 102 (b) as being anticipated by Page (U.S. Patent No. 6,285,999).

With respect to claim 1, as best understood, Page discloses a computer-implemented method for generating search preferences from user input, the method comprising: identifying input authority weights for a plurality of pages (the ranks backlinks)(column 2, line 50+), wherein an input authority weight represents a user's weight of a page in terms of interest (see column 7, line 35-55); distributing a page's initial authority weight over one or more pages that are linked in a graph to the page (see column 2, line 50+) with distribution occurring recursively over links (see column 2, line 67+ and column 3, line 1+) and pages until an end condition is met (see column 6, line 9+); and using a resulting authority weight for a page in effecting a search result list. (see column 8, line 5+).

With respect to claim 2, Page discloses effecting the search result list comprises one or more of reordering search hits (see column 6, line 1-5) and highlighting search hits (highly visible links) (see column 7, line 27-35).

With respect to claims 5-6, Page discloses combining an authority vector for one or more predetermine reference pages with an authority vector for one or more user-specific pages of the plurality of pages (see column 8, line 40+).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Page (U.S. Patent No. 6,285,999) in view of Haveliwala et al. ("Topic Sensitive PageRank", internet citation, 7 may 2002, pages 1-17).

With respect to claims 3-4, Page discloses all limitations of claimed invention recited in claim 1 except for the end condition is that a predetermined number o links are traversed and threshold of authority weight. However, Haveliwala et al. discloses the end condition is that a predetermined number o links are traversed and threshold of authority weight (see page 2, line 35-42). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify Page's system's by having the different end condition in order to have rank stabilizes for the

Art Unit: 2163

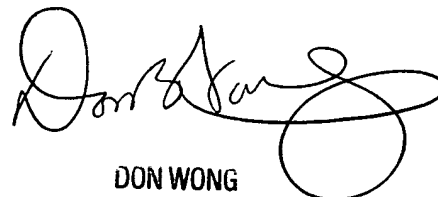
stated purpose has been well known in the art as evidenced by teaching of Haveliwala (see page 2, last 2 line).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung T. Vy whose telephone number is 571-2721954. The examiner can normally be reached on 8.30am - 5.30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571 272 1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DON WONG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Hung T. Vy
Art Unit 2163
September 14, 2006.